IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Kitsukawa	Art Unit: 2611
Serial No.: 09/834,511	Examiner: Chung
Filed: April 13, 2001	50P4372
For: **SYSTEM AND METHOD FOR PUSHING INTERNET CONTENT ONTO INTERACTIVE TELEVISION**	June 28, 2005 750 B STREET, Suite 3120 San Diego, CA 92101

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

Table of Contents

Section	Title	Page
(1)	Real Party in Interest	2
(2)	Related Appeals/Interferences	2
(3)	Status of Claims	2
(4)	Status of Amendments	2
(5)	Concise Explanation of Subject Matter in Each Independent Claim.	2
(6)	Grounds of Rejection to be Reviewed	3
(7)	Argument	4
App.A	Appealed Claims	
App.B	Evidence Appendix	
App.C	Related Proceedings Appendix	

(1) Real Party in Interest

The real party in interest is Sony Corp.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1-37 are pending, Claims 26-37 have been canceled, and Claims 1-25 have been twice rejected, which rejections are the subject of this appeal.

(4) Status of Amendments

No amendments are outstanding.

(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 recites a method for providing Internet content via an interactive television (22, figures 1 and 2, page 7, line 3). The method includes prompting at least one consumer via the interactive television for input regarding topics of interest, and receiving consumer input regarding topics of interest, figure 4, page 13, lines 4-9. The consumer input is transmitted to a server (14, 18, figure 1, page 6, lines 1-7 and figure 4, page 13, lines 10-12. According to Claim 1, the method also includes downloading the Internet content regarding topics of interest to the interactive television as the content regarding topics of interest becomes

available and prior to receiving a consumer request for the Internet content, page 13, penultimate paragraph and page 14, lines 5-7.

The reference numerals regarding the elements of Claim 1 are incorporated herein. Claim 2 sets forth a method for providing Internet content via an interactive television (22, id.) that includes determining at least one topic of interest for at least one consumer without the user specifying the topic, and notifying the consumer via the interactive television regarding Internet content concerning the topic of interest (figure 6, page 14, lines 17-19).

The third independent claim (15) recites an interactive television system that includes at least one Web server having Internet content stored therein (14, figure 1, supra) and at least one interactive television system server (18, figure 1, supra). The system also includes at least one interactive television (22, figures 1 and 2, supra). The interactive television receives Internet content at least from the Web server, and the interactive television system server includes a program for automatically downloading content to the interactive television relevant to topics of interest to at least one consumer. The downloading is based on consumer input regarding user-defined priority levels of topics of interest for different times of day, page 15, lines 7-9.

(6) Grounds of Rejection to be Reviewed on Appeal

(a) Claims 1, 15, and 18-25 have been rejected under 35 U.S.C. §103 as being unpatentable over Shah-Nazaroff et al., USPN 6,317,881, in view of Smith et al., USPN 6,742,033. al.

(b) Claims 2-4 have been rejected under 35 U.S.C. §103 as being unpatentable over Smith et al. in view of Lawler et al., USPN 5,699,107.

(c) Claims 5-14 have been rejected under 35 U.S.C. §103 as being unpatentable over Smith et al. in view of Lawler et al. and Shah-Nazaroff et al.

(d) Claims 16 and 17 have been rejected under 35 U.S.C. §103 as being unpatentable over Shah-Nazaroff et al. in view of Smith et al. and Lawler et al.

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, id., page 49979. Appellant notes that a primary examiner signed out the last Office Action, so it is not expected that prosecution will be reopened in response to this brief. Instead, either allowance, or forwarding to the Board, are expected.

(a) To briefly review the applied references, Shah-Nazaroff et al., the primary reference used against independent Claims 1 and 15, uses viewer feedback to derive a ratings system. As best understood, the only thing sent back to the viewer in Shah-Nazaroff et al. is a program list with ratings. Content itself is not actually pushed, and certainly not based on user-defined content priorities that are keyed to time of day (Claim 15) or as the content regarding topics of interest becomes available and prior to receiving a consumer request for the Internet content (Claim 1).

To remedy this shortfall, the examiner resorts to Smith et al., col. 4, line 63-col. 5, line 12, alleging that this portion of Smith et al. teaches downloading Internet content regarding topics of interest as the content becomes available and prior to receiving a consumer request for the Internet content, as required by Claim 1. This is not what Smith et al teaches at all, however. Instead, the relied-upon section of Smith et al. teaches pre-caching content when the caching strategy deems it appropriate, as opposed to when the content becomes available. Indeed, pushing the content on an availability basis instead of on a programmed caching basis would frustrate the purpose of Smith et al., which is to provide an automatic caching strategy.

So why does Claim 1 remain rejected? Because "the examiner takes a broader interpretation..."as it becomes available" is a relative limitation [that could mean] five milliseconds after it is available, half a second after it is available..."

Two logical fallacies leap out from this response. The first is its irrelevance. Appellant is not claiming some range of availability, but rather making a much larger distinction, namely, that Smith et al. doesn't do anything on an as-available basis, but rather on a pre-caching strategy that withholds available content until such time as the algorithm determines it should be sent. There simply is no relevance to how thin one might rhetorically slice the availability salami.

The second fallacy is an all-too common one, namely, that under the guise of broad claim interpretation during prosecution, an apple may be declared to be an orange to support a rejection. That, however, is not what MPEP §2111.01 says about broad claim interpretation. There is a string attached - claims may be interpreted only so broadly as one skilled in the art would interpret them. And therein lies the defect in the rejection. A programmed pre-caching strategy based on an algorithm that uses past user

input to determine when to cache (Smith et al.) most emphatically would not be regarded by the skilled artisan as automatically downloading content as soon as it becomes available (Claim 1).

Furthermore, the rejection uses Smith et al. to modify Shah-Nazaroff et al. to download its information using the algorithm of Smith et al. But recall that the only thing sent back to the viewer in Shah-Nazaroff et al. is a program list with ratings, not content itself as recited in Claim 1. Accordingly, even if Smith et al. were to be combined with Shah-Nazaroff et al. in the way proposed, Claim 1 would not result, but rather the program list only of Shah-Nazaroff et al. would be pre-cached using the algorithm of Smith et al.

And therein lies the final defect in the rejection. Considering the references as a whole, as opposed to impermissible piecemeal application of individual references, while the pre-caching algorithm of Smith et al. may make sense in the context of actual content, it makes no sense in the context of Shah-Nazaroff et al., because viewers typically desire to review program listings whenever they wish to do so to attain an understanding of future programming. Delaying presentation of the listing of Shah-Nazaroff et al., as would occur were the programmed pre-cache of Smith et al. to be incorporated, thus would make no sense in the context of Shah-Nazaroff et al. and hence it fails to find a ***prior art*** suggestion to combine.

Turning to Claim 15, it is admitted that the primary reference fails to teach downloading anything using user-defined priority levels of topics of interest for different times of day, but it is alleged that Smith et al., col. 4, line 63 to col. 5, line 12 and col. 6, lines 9-18 remedies the shortfall. However, the user of Smith et al. does not get to choose what content is displayed when - that is done automatically by the caching system based on usage patterns that might be very different from time of day priorities that the user might actually desire to implement despite his or her past usage patterns. Indeed, the examiner explicitly makes

this admission in the rejection of Claim 2, discussed further below. Because Smith et al. appears to focus on automatic caching somewhat analogously to hard disk drive caching, and because allowing a user to disrupt the caching strategy by defining what essentially would be *ad hoc* priorities would thus frustrate Smith et al., it is Appellant's position that Claim 15 is contraindicated by Smith et al. There simply is nothing that is user-defined in Smith et al., only things that are defined by the algorithm of Smith et al.

The above observation has been met with another *non-sequitur*, namely, that Appellant is guilty of "attacking references individually". What Appellant is guilty of is pointing out why combining Smith et al. with Shah-Nazaroff et al. would not result in Claim 15, and moreover why Smith et al. itself cannot be modified to reach Claim 15. It is requested that the rejections under part (a) be reversed.

Various dependent claim rejections under this section are also defective. For instance, contrary to what is alleged, nothing in Shah-Nazaroff et al. teaches filtering future server queries at least partially based on the consumer interest pattern. In fact, it does not appear that Shah-Nazaroff et al. contemplates "server queries" at all.

(b) Claim 2 has been rejected based on a different combination of references, namely, Smith et al. and Lawler et al. Tellingly and apropos the previous rejections, the examiner admits in the rejection of Claim 2 that Smith et al. fails to allow the user to specify the topic of interest, conceding that this is done by the algorithm instead. Lawler et al., col. 11, lines 40-67 is relied on as a teaching that a user is reminded of when a TV program is to be broadcast. However, since, as readily admitted in the Office Action, Smith et al. is directed to choosing content for the user, and not to allowing a user to specify the content, manifestly there is no prior art reason to combine the reminder of Lawler et al. with Smith et al., because there is no

user-selected program in Smith et al. to remind the user of in the first place. The rejection is a classic case of hindsight reconstruction of an invention using multiple references that have no prior art reason for combining them in the way proposed.

(c) For reasons stated above, insufficient prior art motivation exists to combine the references as proposed. Moreover, the defects of the prior art relative to their lack of teaching the subject matter in the claims rejected under this section have also been discussed and are incorporated herein.

(d) For reasons stated above, insufficient prior art motivation exists to combine the references as proposed. Moreover, the defects of the prior art relative to their lack of teaching the subject matter in the claims rejected under this section have also been discussed and are incorporated herein.

Respectfully submitted,

John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

1168-11.APP

APPENDIX A - APPEALED CLAIMS

1. A method for providing Internet content via an interactive television, comprising the acts of:

prompting at least one consumer via the interactive television for input regarding topics of interest;

receiving consumer input regarding topics of interest;

transmitting the consumer input to a server; and

downloading the Internet content regarding topics of interest to the interactive television as the content regarding topics of interest becomes available and prior to receiving a consumer request for the Internet content.

2. A method for providing Internet content via an interactive television, comprising the acts of:

determining at least one topic of interest for at least one consumer without the user specifying the topic; and

notifying the consumer via the interactive television regarding Internet content concerning the topic of interest.

3. The method of Claim 2, further comprising the act of:
downloading the Internet content to the interactive television.

4. The method of Claim 3, wherein Internet content regarding the topic of interest is downloaded prior to receiving a request for the Internet content.

5. The method of Claim 2, wherein the topic of interest is determined by:
prompting the consumer via the interactive television for input regarding topics of interest, the topics being associated by the user with a time of day.

6. The method of Claim 5, further comprising the acts of:
receiving consumer input regarding topics of interest; and
transmitting the consumer input to a server.

7. The method of Claim 6, wherein the server is a Web server.

8. The method of Claim 6, wherein the server is an interactive television server.

9. The method of Claim 1, further comprising the acts of:
prompting the consumer via the interactive television for input regarding priority of the topics of interest.

10. The method of Claim 9, further comprising the acts of:
receiving consumer input regarding priority of the topics of interest; and
transmitting the consumer input to a server.

11. The method of Claim 10, further comprising the acts of:
determining priority of Internet content relevant to the topics of interest; and
downloading content relevant to the topic of interest based on the priority.

12. The method of Claim 2, wherein the topic of interest is determined by:
monitoring consumer responses to interactive television system server inquiries to establish at least one consumer interest pattern.

13. The method of Claim 12, further comprising the act of:
recording the consumer interest pattern.

14. The method of Claim 13, further comprising the act of:
filtering future server queries at least partially based on the consumer interest pattern.

15. An interactive television system, comprising:
at least one Web server having Internet content stored therein;
at least one interactive television system server; and
at least one interactive television, the interactive television receiving Internet content at least from the Web server, the interactive television system server including a program for automatically downloading content to the interactive television relevant to topics of interest to at least one consumer based on consumer input regarding user-defined priority levels of topics of interest for different times of day.

16. The system of Claim 15, wherein the program includes:
logic means for determining at least one topic of interest for at least one consumer; and
logic means for notifying the consumer via the interactive television regarding Internet content concerning the topic of interest.

17. The system of Claim 16, wherein the further program includes:
logic means for downloading the content to the interactive television.

18. The system of Claim 15, wherein the program includes:
logic means for prompting the consumer via the interactive television for input regarding topics of interest.

19. The system of Claim 18, wherein the program further includes:
logic means for receiving consumer input regarding topics of interest; and

logic means for transmitting the consumer input to a server.

20. The system of Claim 15, wherein the program further includes:
logic means for prompting the consumer via the interactive television for input regarding priority of the topics of interest.

21. The system of Claim 20, wherein the program further includes:
logic means for receiving consumer input regarding priority of the topics of interest along with associated times; and
logic means for transmitting the consumer input to a server.

22. The system of Claim 15, wherein the program further includes:
logic means for determining priority of Internet content relevant to topics of interest; and
logic means for downloading content relevant to the topic of interest based at least on the priority.

23. The system of Claim 15, wherein the program includes:
logic means for monitoring consumer responses to interactive television system server inquiries to establish at least one consumer interest pattern.

24. The system of Claim 23, wherein the program further includes:
logic means for recording the consumer interest pattern.

25. The system of Claim 24, wherein the program further includes:
logic means for filtering future server queries at least partially based on the consumer interest pattern.

APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)